

Docket No. 1567.1015/JGM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

DuckChul HWANG et al.

Group Art Unit: 1745

Serial No: 09/910,952

Examiner: Laura S Weiner

Confirmation No. 3638

Filed: July 24, 2001

For: ELECTROLYTE FOR A LITHIUM-SULFUR BATTERY AND A LITHIUM-SULFUR BATTERY USING THE SAME

RESPONSE TO RESTRICTION REQUIREMENTCommissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed November 7, 2003, having a shortened period for response set to expire on December 8, 2003 (December 7 being a Sunday), the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect claims 2 and 29 of the first solvent of Species I, and claims 2-4, 8-17, and 25-30 (Group IIIb) in response to the preliminary restriction requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

As an initial point of clarification, the Examiner asserts on page 2 of the Office Action that no claims are considered generic. However, it is respectfully submitted that at least claims 4, 10, and 12 of Group IIIb are generic to corresponding depending claims 5-7 and 18-24 of Group IIIa and due to the use of the word "comprising," which does not preclude the use of an additive. MPEP 2111.03. It is further noted that at least claims 4-13 and 18-24 are generic to Groups I and II in that claims 4-13 and 18-24 are not restricted as to a type of first and second solvents, with at least claim 4 of Group IIIb being generic to depending claims 29 and 30 of Groups I and II. As such, it is respectfully submitted that at least the above claims are generic as set forth above.

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Insofar as Groups I, II and IIIa are concerned, it is believed that the claims of Groups I, II, and IIIa are so closely related to the elected claims of Group IIIb that they should remain in the same application to avoid imposing any undue burden, expense, and delay on the Applicants in preserving the invention recited in the claims of Groups I, II, and IIIa. Specifically, the Examiner has not provided evidence that the Examiner will experience an undue burden in searching and examining the invention set forth in Species I through IIIb. The Examiner also has not provided evidence that the existence of four species represents an unreasonable number of species to be searched, and has not provided a rationale as to why the invention is to be separated into Species I through IIIb. Lastly, since the Examiner has already performed a search of the technology for the claims of Species I through IIIb as evidenced by the Office Action mailed June 11, 2003, it is unclear as to how the Examiner's burden has increased with regard to a search of the same technology or how the number of species has now become unreasonable at this point in prosecution sufficient to invoke a requirement of election between species.

In contrast and consistent with the requirements in MPEP 803 and 808, the Examiner needs to provide a rationale as to why an election is required or how, without the election, the Examiner is unduly burdened in comparison with the burden visited on the applicants in the extra delay and expense in obtaining protection for each Species.

As such, it is respectfully submitted that the Examiner has not presented sufficient evidence of a burden on the Examiner in examining Species I through IIIb which is out of proportion with the delay and expense visited on the applicants in protecting the invention recited in Species I through IIIa so as to show an undue burden on the Examiner so as to also require an election between these species.

III. Conclusion

Upon review of references involved in this field of technology, when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

If any further fees are required in connection with the filing of this Response, please charge the same to our deposit account number 19-3935.

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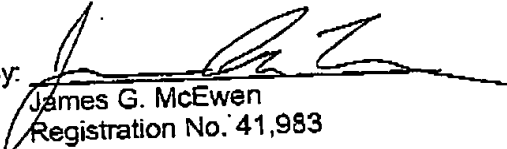
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Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

STAAS & HALSEY LLP

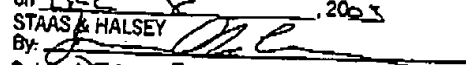
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Date: DEC. 8, 2003

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P.O. Box 1450, Alexandria, VA 22313-1450
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